

REMARKS

In response to the Office Action mailed December 6, 2000, Applicants hereby elect, with traverse, for further prosecution in this application that invention identified in the Office Action as Invention I, claims 1-43, 79, 87-89, and 95-98 drawn to a composition. This restriction requirement is respectfully traversed.

Favorable reconsideration and allowance are respectfully requested. Claims 1-109 are pending and at issue.

The Examiner required restriction to one of the following inventions under 35 U.S.C. § 121:

- I. Claims 1-43, 79, 87-89, 95-98, drawn to an intermediate;
- II. Claims 44-47, 80-86, 90-94, drawn to a method of making;
- III. Claims 78, 99, 100-109, drawn to a composition.

The Examiner asserted that the inventions defined by Groups I-III are unrelated and patentably distinct. Specifically, the Examiner asserted that the claims of Groups I and III are related as mutually exclusive species in an intermediate-final product relationship. Further, the Examiner stated that the claims of Group I and II are related as process of making and product made.

Applicants respectfully traverse the requirement for restriction in this application and request its modification or withdrawal. For the reasons which follow, Applicants submit that it would be in the best interests of the public if all the claims were to issue and to expire in the same patent.

One of the requirements for a proper restriction requirement is that searching the entire invention must constitute an undue burden to the Examiner. MPEP § 803. The fact that the claims merely recite distinct inventions is not sufficient.

While the inventions are classified in separate classes and subclasses, it should be noted that all the inventions involve the same inventive concept of introduction of functional groups onto the surface of fibrils. Hence, searching any of the inventions, as outlined by the Examiner, would involve a search of methods for functional modification of fibril surfaces and new compositions of matter based upon the functionalized fibrils. Thus, it is submitted that searching all the claims would not constitute an undue burden as the searches overlap.

On the other hand, it is respectfully submitted that dividing the claims into three separate patents creates an undue burden on Applicants and the public. If the restriction requirement is maintained, Applicants will be forced to pay issue and maintenance fees on four separate patents. Additionally, in view of the changes to the patent term covered by GATT, Applicants period of exclusivity could be greatly reduced. The public is better served by having all the claims issue together since they will know the full scope of patent protection at the outset and will not have to wait and see if further patents issue.

Accordingly, reconsideration of the restriction requirement is respectfully requested.

The Examiner is invited to telephone the undersigned in order to resolve any issues that might arise and to promote the efficient examination of the current application.


The fee for this extension is estimated to be \$945.00 for a Small Entity. Please charge the required fee to Deposit Account No. 50-0540. No additional fee is believed necessary for entry of this Amendment. However, the Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 50-0540.

Respectfully submitted,

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